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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,710	07/30/2003	Shuzhong Wang	239967US0CONT	5362
22850	7590	03/09/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			COVINGTON, RAYMOND K	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,710

Applicant(s)

WANG ET AL.

Examiner

Raymond Covington

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/30/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicants' Information Disclosure Statement filed July 30, 2003 does not contain a PTO-1449 pursuant to MPEP 609.

The term "acting" appears at numerous places in the claims and in the specification. As the term is presently set forth, it appears applicants intended the term to be -- reacting --. Correction or clarification is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for making difluorocyclohexane-carboxylic acid, does not reasonably provide enablement for a method for making organic group containing compounds per se. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. There is insufficient disclosure of starting materials that would place such a diverse genus of compounds in possession of the public in the event of a patent grant. In addition, there is no reasonable assurance that such an alleged genus of compounds would possess all of the alleged properties for use. See *In re Fouche* 169 USPQ 429

((CCPA 1971)). Quite clearly, more than routine experimentation would be required to place the claimed compounds, compositions and methods of use in possession of the public in the event of a patent grant. See *In re Armbruster*, 185 USPQ 152 (CCPA 1975).

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for making difluorocyclohexane-carboxylic acid, does not reasonably provide enablement for a method for making heterocyclic group containing compounds per se. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The specification does not give any guidance as to how each of the heterocyclic group containing derivatives were prepared. In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described. They are:

1. The nature of the invention,
2. The state of the prior art,
3. The predictability or lack thereof in the art,
4. The amount of direction or guidance present,

5. The presence or absence of working examples,
6. The breadth of the claims,
7. The quantity of experimentation needed, and
8. The level of the skill in the art.

In the instant case, Applicants have not disclosed any working examples, which would demonstrate, or guide, one skilled in the art as to how the heterocyclic substituted derivatives were prepared or obtained. The process of making the heterocyclic substituted derivatives or how the heterocyclic substituted derivatives were obtained is not readily apparent from the specification. The specification must teach how to make the invention. *In re Gardner*, 166 U.S.P.Q. 138 (1970). In order to practice the claimed invention, one skilled in the art would have speculate how the derivatives were obtained or prepared. Therefore, the instant invention is not enabled. Claims limiting the scope of these terms should overcome this rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bieron et al US 4,792,618 taken with Chambers et al WO 96/03357.

Bieron et al teach a process of fluorinating an organic compound in the same type manner as recited in the claims. See, for example, column 3 line 64 to column 4 line 70. Patentees differ in that gem difluoro substituted products derived from a keto starting material is not specifically exemplified. However, Chambers et al teach an analogous process for making selectively fluorinated organic compounds from thio-keto starting materials. To modify Bieron et al to include this technique would have been obvious to one of ordinary skill in the art as the results, via the use of somewhat different but otherwise analogous starting materials ($=O$ in lieu of $=S$), would not have been unobvious and therefore unpatentable.

No claim is allowed.

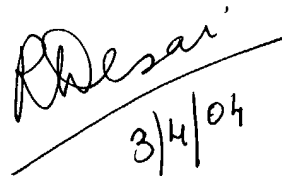
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (703) 308-4704. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RKC

Raymond Covington
Examiner
Art Unit 1625


3/4/04

**RITA DESAI
PRIMARY EXAMINER**